



IFW

Attorney Docket No. 47113-5094  
**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re PATENT APPLICATION of:

Erik BERMINGE et al.

Application No.: 10/589,944

Filed: August 18, 2006

FOR: CUTTING TOOL AND ASSOCIATED  
TOOL HEAD

:  
:  
: Confirmation No.: 2359  
:  
: Group Art Unit:  
:  
: Examiner:  
:  
:  
:

**SUBMISSION OF INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

Commissioner for Patents  
U.S. Patent and Trademark Office  
**Customer Window Mail Stop:**  
Alexandria, VA 22314

Sir:

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(d), Applicant submits a copy of an International Preliminary Report of Patentability dated September 22, 2006. All the references cited in the attached Search Report have previously been submitted to the U.S. Patent and Trademark Office in this application. This Submission is being filed before the mailing date of a first Office Action on the merits.

Should any questions arise in connection with this application, or should the Examiner believe a telephone conference would be helpful in resolving any remaining issues pertaining to this application, it is respectfully requested that the undersigned be contacted at the number indicated below.

Except for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this Application, including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required and including any required extension of time fees, or credit any overpayment to Deposit Account

No. 50-0573. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR  
EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully Submitted,

Date: May 16, 2007  
DRINKER BIDDLE & REATH LLP  
Customer No. 55694  
1500 K Street, N.W., Suite 1100  
Washington, D.C. 20005-1209  
Tel. No.: 202-842-8800  
EPS:mk

By:



Elaine P. Spector  
Reg. No. 40,116  
Attorney for Applicants  
Tel. No.: (202) 842-8863  
Fax No.: (202) 842-8465

CN  
KR  
US

PATENT COOPERATION TREATY

PCT/SE2005/000245

From the INTERNATIONAL BUREAU

**PCT** 2006-09-22

NOTIFICATION CONCERNING  
TRANSMITTAL OF COPY OF INTERNATIONAL  
PRELIMINARY REPORT ON PATENTABILITY  
(CHAPTER I OF THE PATENT COOPERATION  
TREATY)

(PCT Rule 44bis.1(c))

To:

TÅQUIST, Lennart  
Sandvik AB  
Intellectual Property  
S-811 81 Sandviken  
SUÈDE

Date of mailing (day/month/year)  
14 September 2006 (14.09.2006)

Applicant's or agent's file reference  
JK 11991 WO

IMPORTANT NOTICE

International application No.  
PCT/SE2005/000245

International filing date (day/month/year)  
22 February 2005 (22.02.2005)

Priority date (day/month/year)  
03 March 2004 (03.03.2004)

Applicant

SANDVIK INTELLECTUAL PROPERTY AB et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Authorized officer

Philippe Becamel

Facsimile No. +41 22 338 82 70

e-mail: pt12@wipo.int

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference JK 11991 WO	<b>FOR FURTHER ACTION</b>	See item 4 below
International application No. PCT/SE2005/000245	International filing date ( <i>day/month/year</i> ) 22 February 2005 (22.02.2005)	Priority date ( <i>day/month/year</i> ) 03 March 2004 (03.03.2004)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant SANDVIK INTELLECTUAL PROPERTY AB		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis. I(a).
  2. This REPORT consists of a total of 4 sheets, including this cover sheet.
- In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- |                                     |              |   |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I    | Basis of the report   |
| <input type="checkbox"/>            | Box No. II   | Priority  |
| <input type="checkbox"/>            | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/>            | Box No. IV   | Lack of unity of invention  |
| <input checked="" type="checkbox"/> | Box No. V    | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/>            | Box No. VI   | Certain documents cited   |
| <input type="checkbox"/>            | Box No. VII  | Certain defects in the international application  |
| <input type="checkbox"/>            | Box No. VIII | Certain observations on the international application   |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 05 September 2006 (05.09.2006)
Facsimile No. +41 22 338 82 70	Authorized officer  <div style="text-align: center; font-weight: bold;">Philippe Becamel</div> e-mail: pt12@wipo.int

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

REC'D 01 JUL 2005

To:

Sandvik AB  
Intellectual Property  
811 81 SANDVIKEN  
SVERIGE

**PCT**

WIPO

PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing  
(day/month/year) **26-05-2005**

Applicant's or agent's file reference

JK 11991 WO

**FOR FURTHER ACTION**

See paragraph 2 below

International application No.

PCT/SE2005/000245

International filing date (day/month/year)

22.02.2005

Priority date (day/month/year)

03.03.2004

International Patent Classification (IPC) or both national classification and IPC

B23B 27/10

Applicant

Sandvik AB et al

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further opinions, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/SE  
Patent- och registreringsverket  
Box 5055  
S-102 42 STOCKHOLM

Authorized officer

Fredrik Strand / MRO

Facsimile No. +46 8 667 72 88

Telephone No. +46 8 782 25 00

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/SE2005/000245

**Box No. I**      **Basis of this opinion**

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language, \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing  
☐ contained in the international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/SE2005/000245

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	1-10	YES
	Claims		NO
Inventive step (IS)	Claims	1-10	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-10	YES
	Claims		NO

2. Citations and explanations:

Cited documents:

1. US 6634835 B1
2. DE 3434653 A1
3. EP 0636442 A1
4. DE 8126791 U

The documents cited in the International Search Report represent background art.

The invention defined in claims 1-10 is not disclosed by any of these documents.

None of the cited documents gives any indication towards the claimed cutting tool for parting and grooving operations provided with means for coolant supply arranged in the tool head.

No relevant combination of the cited documents would lead a person skilled in the art to the invention defined in the claims.

Therefore, the invention defined in claims 1-10 is novel and is considered to involve an inventive step. It is also considered to be industrially applicable.